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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/590,434	06/09/2000	Dean F. Jerding	A-6594	1996

5642 7590 05/23/2003

SCIENTIFIC-ATLANTA, INC.  
INTELLECTUAL PROPERTY DEPARTMENT  
5030 SUGARLOAF PARKWAY  
LAWRENCEVILLE, GA 30044

EXAMINER

BELIVEAU, SCOTT E

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/590,434

Applicant(s)

JERDING ET AL.

Examiner

Scott Beliveau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 1-5, 16-21 and 23-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-15 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-5, 16-21 and 23-36 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, 20-21, 28-36, drawn to an interactive media guide with a system operator interface, classified in class 725, subclass 93.
  - II. Claims 6-15, 22, drawn to a method for an interactive media guide with promotional/preview functionality, classified in class 725, subclass 8.
  - III. Claims 16-19, drawn to establishing a reservation for an interactive media guide that is operable to facilitate programming reservations, classified in class 725, subclass 58.
  - IV. Claims 23-27, drawn to an interactive media guide which serves as a screen saver utility, classified in class 345, subclass 867.
  - V. Claims 37-42, drawn to a method for providing VOD control options and branding content, classified in class 725, subclass 87.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I, II, III, IV, and V are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case:

  - Invention I has separate utility from inventions II-IV such that the invention provides a means wherein a system operator to determines what information in an interactive media guide is to be displayed to the user. The interactive media guides of Inventions II-III may be configured locally based on user profile

information, or through other user customization. While Invention IV is directed at a system operator configuration, it is distinct insofar as Invention I does not relate to the configuration of screen saver parameters. Invention V is distinctive in that the control options and branding, is not related to the control of promotional material rather it is directed towards the client control of active media playback;

- Invention II has separate utility from inventions I, and III-V such that the method is directed towards an interactive media guide that facilitates the delivery of promotional material and purchase requests related to this material. Accordingly, the interactive media guide of Invention II is separately usable from program guides that are configurable using a server side interface, facilitate recording reservations, provide screen saver functionality, or VOD playback control options;
- Invention III has separate utility from inventions I-II, and IV-V such that the Invention is directed towards the establishment of a reservation to record programs of interest. Accordingly, the interactive media guide of Invention III is separately usable from program guides that are configurable at the server side, merely display/provide promotional material, provide screen saver functionality, or VOD playback control options;
- Invention IV has separate utility from inventions I-III, and V such that the invention is operable to prevent burn-in on a user screen;

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- Invention V has separate utility from inventions I-IV such that the means for providing branding content in addition to playback controls may be implemented separately from an interactive media guide.

See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Shelley Couturier on 29 April 2003 a provisional election was made to prosecute the invention of II, claims 6-15, and 22 with an option to traverse the prosecution of invention III, claims 16-19. The applicant in replying to this Office action must make affirmation of this election. Claims 1-5, 16-21, and 23-36 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Priority***

4. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

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The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994). Accordingly, for the purposes of evaluation of prior art, the application filing date shall be the filing date of the instant application or 09 June 2000.

In consideration of the applicant's claim for priority, it is the examiner's position that the information disclosed in the provisional application only comprises the information of Pages numbered 1-5. The remainder of the provisional application includes references to a number of patent and patent applications, in addition to a number of supporting materials/documents, however it is the examiner's position that these materials have not been properly incorporated into the provisional application such that the instant application would receive the benefit of an earlier filing date.

As to the patent and patent applications, the provisional application fails to properly incorporate the material by reference in so far as there is no reference as to what is actually being incorporated other than simply the references to the patents/applications. As an aside, it is further noted that all of the references, if patented, would appear to qualify as prior art under 35 U.S.C. 102(e). As to the attached documents (referenced on pages 4-5), there is no reference that these documents are actually part of the disclosure/application given that they are not "incorporated by reference in their entirety". The disclosure simply references these

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documents as “further describing aspects of the invention”. The reference to another application, patent, or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C. 112, first paragraph. In re de Seversky, 474 F.2d 671, 177 USPQ 144 (CCPA 1973). See MPEP § 608.01(p).

***Request for Information***

5. The US Provisional application 60/138,756 upon which priority was sought for the instant application includes the following attached documents:

- Client User Interface Specification for Video-On-Demand Application Development on the Explorer 2000™ Digital Home Communications Terminal, revision 1.10 of 8/31/98;
- VOD Title Catalog Format;
- VOD Client Software Design Specification, version 0.5 of 4/23/98;
- Video-On-Demand Architecture Specification for the SARA VOD Application Server Interface;
- The “AIS VOD Component” Overview;
- The “Generic VOD Architecture” Overview;
- System Architecture Specification for Video-On-Demand Application Development on the Explorer 2000™ Digital Home Communications Terminal, revision 1.01r of March 1999;

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- System Architecture Specification for Service Group Determination of Scientific Atlanta Digital Broadband Delivery System, revision 1.00 of February 1999;
- System Architecture Specification Digital Broadband Delivery System User-to-Network Configuration, revision 1.00 of June 1999; and
- System Architecture Specification Digital Broadband Delivery System Service Interactive Sessions, revision 1.00 of June 1999;

The examiner is unclear as to the nature of these documents with respect to them constituting prior art under 35 USC 102. The aforementioned documents appear to be “printed publications” that “describe” the claimed aspects of the invention prior to the filing of the instant application and are furthermore each authored by a different inventive entity than the instant application. The examiner cannot find any indication that these documents were for internal use only. The “Client User Interface Specification for Video-On-Demand Application Development on the Explorer 2000™ Digital Home Communications Terminal, revision 1.10 of 8/31/98” document by Shashi Goel discloses that the claimed invention was “to be deployed for demonstration in the field, in September 1998” (Page 3, Section 1.2). The System Architecture Specification for Video-On-Demand Application Development on the Explorer 2000™ Digital Home Communications Terminal, revision 1.01r of March 1999” document by Timothy Addington references that the “S-A propriety notice” has been removed from the document and that it was “released to Pegasus VOD Design team” (Page ii, Revision History). It is the examiner’s understanding that the Pegasus was a project sponsored by Time Warner Cable whereupon the assignee of this application Scientific Atlanta™ was selected as a prime contractor (<http://twcable.web.aol.com/Pegasus/>).



Accordingly, the examiner requests for the applicant to provide clarification on the record as to the prior art nature of these documents and in particular provide comments regarding the inventorship of the claimed material, comments pertaining to the removal of propriety notices coinciding with the “release” of the document by Timothy Addington, and the suggestion of “public use” raised by the Shashi Goel document.

### *Drawings*

6. Corrected or substitute drawings were received on 30 October 2000. These drawings are disapproved as referenced in the subsequent drawing objections.
7. Figures 4C and 4D are objected to because the specification describes the illustration as the MOD initialization scenario, however the element label appears to reference the “VOD server” [22] as opposed to the “MOD server” [19] (Page 9, Lines 12-22). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
8. Figure 4H is objected to because the specification describes processes utilizing MOD requests, however the elements label reference the requests as “VOD” requests” (Page 11, Lines 12-22). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
9. Figure 7 is objected to because the specification describes the referenced element “188” as the “guide button”, however, the arrow is pointing to the “TV button” of the remote control (Page 13, Line 24). A proposed drawing correction or corrected drawings are

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required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

10. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: 84 (Figure 4D), 98 (Figure 4E), 195, 193 (Figure 5), and 189 (Figure 7). A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
11. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “270” has been used to designate both the VOD rental screen and the “lower portion of the display (Figure 19A). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
12. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 271 (Page 27, Line 27). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Specification*

13. The disclosure is objected to because of the following informalities:

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- Reference to “application servers 14” should be amended to reference “application servers 20” (Page 4, Line 27);
- Reference to “a Digital Storage Media – Command-in-Control (DSM-CC) 34 session and resource manager 34” should be amended to read “a Digital Storage Media – Command-in-Control (DSM-CC) session and resource manager 34” to remove the redundant element number (Page 4, Line 32);

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 6-7, and 9-12 is rejected under 35 U.S.C. 102(e) as being anticipated by Knudson et al. (US Pat No. 6,526,577).

In consideration of claim 6, the Knudson et al. reference discloses a method for “implementing” a client device [28] to tune to one of a “plurality of promotional channels” or barker channel [1600] through an interactive media guide (Col 13, Lines 55-67 – Col 13, Lines 1-17). The “promotional channel” is operable to “present” a plurality of “promotional media” through a video window [1611] (Col 13, Lines 46-60). The embodiment

subsequently “accepts requests” [1625] from the user to “proceed to a purchase environment” [552] for “one of said plurality of promotional media” associated with the movie being currently being displayed (Col 12, Lines 58-66; Col 13, Lines 18-45).

Claim 7 is rejected wherein the reference discloses that the “promotional media” may comprise an “iterative sequence of movie trailers” (Col 13, Lines 46-51).

Claim 9 is rejected wherein the Knudson et al. reference discloses a method wherein a client device [28] is operable to “implement an interactive media guide” (Col 7, Lines 28-33). As aforementioned, the embodiment includes a “promotional channel” that is operable to “present” through a video window [1611] “more information regarding a media title” in the form of “a plurality of “promotional media” (Col 13, Lines 18-60).

Claim 10 is rejected wherein the “promotional media” is displayed in a “segmented area of said interactive media guide” [1611].

Claim 11 is rejected wherein the “promotion media is a preview presenting a small duration of a media stream” (Col 13, Lines 36-45).

Claim 12 is rejected wherein the “promotional media comprises a trailer of said requested media title” (Col 13, Lines 46-51, 61-67 – Col 14, Lines 1-4).

16. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Hendricks et al. (US Pat No. 6,526,577).

Claim 9 is further rejected in view of Figures 16-17 of the Hendricks et al. reference which illustrates an “interactive media guide” [1197] that is “implemented” and “presented” to a user via a “client device” [220]. As illustrated in Figure 16, the embodiment is operable to “accept requests” to “present more information regarding a media title” (Col 35, Lines 2-

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4). Subsequent to accepting the request, the embodiment is operable to “provide one of said plurality of promotional media associated with said media title” in conjunction with a subsequent request for a preview clip (Figure 17) (Col 36, Lines 10-29).

17. Claim 22 is rejected under 35 U.S.C. 102(e) as being anticipated by LaJoie et al. (US Pat No. 5,850,218).

In consideration of claim 22, Figure 32 of the LaJoie et al. reference discloses a method for “implementing an interactive media guide” [540] that is presented through a client device [6]. The embodiment “accepts a request” by the user to “preview one of a plurality of preview media” in conjunction with the selection of the “media listed in said interactive media guide”. Subsequent to the completion of the “presentation” of the “preview media”, the user is “prompted” to “purchase media associated with [the] preview” (Col 32, Lines 22-43).

18. Claim 13 is rejected under 35 U.S.C. 102(e) as being anticipated by Candelore et al. (US Pat No. 5,774,170)

In consideration of claim 13, the Candelore et al. reference discloses a method wherein a “client device” [170] is operable to present an “interactive media guide” [226] (Col 3, Lines 4-25). The embodiment subsequently “accepts requests from said user to present a media described by said media guide” (Col 8, Lines 32-44; Col 10, Lines 18-27) and at such time the user is given the opportunity to “enable” the server to “insert said plurality of promotional media” such as commercials “as part of the progression of an entire session of said media requested” or to view the requested media free of “promotions” (Col 2, Lines 4-9; Col 10, Lines 54-62).

***Claim Rejections - 35 USC § 103***

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Knudson et al. (US Pat No. 6,526,577), in view of Billock et al. (US Pat No. 5,619,249).

In consideration of claim 8, the Knudson et al. reference does not explicitly disclose nor preclude that the “promotional channel” or barker channel may not be associated with a “particular theme or genre”. The examiner takes OFFICIAL NOTICE that it is notoriously well known in the art for “promotional channels” to be associated with a “particular theme or genre”. An example of such, being “promotional channels” associated with adult programming. Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to associate the “iterative sequence of trailers” with the “particular theme or genre” for the purpose of providing viewers with “trailers” related to the theme of the dedicated programming or media associated with that particular channel.

Assuming arguendo, the examiner relies on the teachings of Billock et al. which illustrates a method for viewing previews of on-demand programming wherein the selection of these programs is facilitated through the designation of a “particular theme or genre” (Col 9, Lines 54-65). Accordingly, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Knudson et al. reference, if necessary, so as to

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provide a means by which a viewer may designate a “particular theme or genre” for the purposes of providing a user friendly means for simplifying the “promotional media” selection process (Billock et al.: Col 9, Lines 54-56)

21. Claims 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Candelore (US Pat No. 5,619,249).

As aforementioned, the Candelore reference discloses a method of presenting “promotional media” or commercials during the “entire session” of requested media. The reference, however, does not explicitly disclose nor preclude that these commercials may not comprise a “sequence of trailers” or a “sequence of trailers of other media in some way associated with said media requested”. The examiner takes OFFICIAL NOTICE that it is notoriously well known for video programming such as movies to contain commercials or “sequences of trailers of other media in some way associated with” the movie. For example, a viewer of children’s movie is typically presented with trailers of “other media” or movies of a similar genre. Accordingly, it would have been obvious to one of ordinary skill in the art to modify the Candelore embodiment, if necessary, to utilize commercials comprising “sequences of trailers of other media in some way associated with the movie” for the purpose of informing viewers of other programs of interest so as to further encourage subscriber loyalty with respect to the ordering of additional programming of interest (Candelore: Col 2, Lines 44-48).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as follows. Applicant is reminded that in amending in response to a rejection of claims, the patentable novelty must be clearly shown in view of the state of the art disclosed by the references cited and the objections made.

- The Dyer et al. (US Pat No. 6,305,019) reference discloses an interactive information distribution system that supports the delivery of information through a barker channel.
- The Ellis (WO 99/60790) reference discloses an interactive television program guide in which a viewer may browse through categories of video-on-demand programs, request additional information pertaining to those programs, and purchase and/or request a preview of the programming.
- The McCoy et al. (US Pat No. 6,526,575) reference discloses a method for defining the presentation of information on a "promotional channel".
- The Nishio (US Pat No. 6,070,186) reference discloses a video-on-demand system that is operable to transmit commercials during a non-transmission periods of on-demand programming.
- The Hite et al. (US Pat No. 5,774,170) reference discloses a means for delivering content based targeted advertisements to viewers in a VOD environment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Beliveau whose telephone number is 703-305-4907. The examiner can normally be reached on Monday-Friday from 8:00 a.m. - 5:30 p.m..

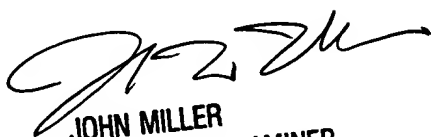


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 703-305-4795. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

SEB  
May 16, 2003



JOHN MILLER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600